

Application No.: 09/915,715
Applicants: Axel von Wolff et al.
Amendment in Response to Office Action dated September 3, 2003

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 3 – 9 are pending. New claims 6 – 9 have been added. Claims 1 and 2 have been canceled in favor new claims 6 and 7. Support for new claims 6 and 7 is found in originally filed claims 1 and 2. Amendments have been made to claims 3-5 for sake of clarity. The subject matter in the “preferably” and “particular preference” clauses of claim 4 are now in the new dependent claims 8 and 9. A mark-up showing the changes that have been made to these claims using strikethrough and underlining is presented above. It is believed that no new matter has been added.

Rejections under 35 U.S.C. 102(a)

The Examiner rejected claims 1, 2, and 4 under 35 U.S.C. 102(a) as being anticipated by Becker et al. (U.S. Patent No. 6,180,229 B1). The Examiner found Becker to teach a method of applying a hot melt pressure sensitive adhesive discontinuous coating on to a substrate directly or by way of a transfer system. In response, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, that the absence in the prior art reference of even a single claim element precludes a finding of anticipation. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Applicants submit Becker does not

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teach the claimed method, and therefore the claims are not anticipated.

The Examiner alleges that Becker at columns 1 and 6 teaches the instantly claimed method. A closer reading of Becker at column 1 reveals a general disclosure of discontinuous coating and at column 6, lines 8-48 reveals a discussion of two types of discontinuous coating, roll coating and pattern coating. Applicants point out that both methods are directed to applying an adhesive by contacting a substrate with a roller-like device containing adhesive therein. The adhesive is generally applied to the roller-like device first, and then subsequently applied to the substrate with the roller-like device to leave adhesive deposits. See Becker, column 6, lines 9-14 and lines 21-29. Applicants submit the adhesive in Becker is not being applied to a moving transfer material at a rate which causes the adhesive to form a film having voids. Moreover, there is no teaching in Becker that the method results in an adhesive which forms a film having voids on the transfer material. Rather Becker shows a plurality of adhesive deposits. See Becker, claim 8. Limitations recited in terms such as "thereby" cannot be disregarded in determining patentability over the prior art. See *Pac Tec, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990). Accordingly, since Becker does not teach a method which comprises "applying a hot-melt pressure sensitive adhesive to a moving transfer material at a rate, relative to the speed of the moving transfer material, that causes the applied hot-melt pressure sensitive adhesive to form a film on said moving transfer material, and said film to be torn as it is being formed, thereby resulting in a film which comprises voids", the claims are not anticipated.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to

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reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Rejections under 35 U.S.C. 103

The Examiner rejected claims 3 and 5 under 35 U.S.C. 103(a) as being obvious in view of Becker et al. Becker was discussed above. The Examiner found the limitations to be conventional and thus obvious. In response, Applicants submit there must be some suggestion or motivation, either in the reference of knowledge generally available to a person skilled in the art to modify the teaching of the reference. See *MPEP* §2143. Regarding claim 3, Applicants point out that because the limitations of the base claims are incorporated into the dependent claims by reference, the limitations of claims 6 and 7 as discussed above cannot be overcome by a slot die as allegedly taught by Becker. Regarding claim 5, Applicants submit there is no suggestion in Becker of a film which has been extended beyond its yield point in such a way that the film tears to form a film comprising voids. Becker clearly contemplates a plurality of adhesive deposits as discussed above in the anticipation rejection, and not a film which comprises voids. Wherefore, the claims are not rendered obvious by Becker.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

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Conclusion

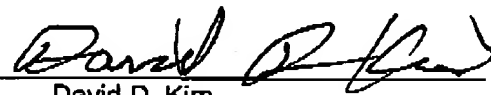
Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

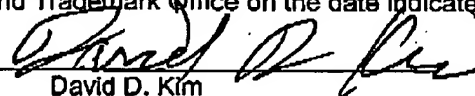
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (9 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: November 26, 2003

By 
David D. Kim